<u>REMARKS</u>

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

<u>*Status of Claims:*</u>

No claims are currently being cancelled.

Claims 7, 9, 13, 15 and 21 are currently being amended.

Claims 22-34 are currently being added.

This amendment and reply amends and adds claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 7, 9, 13, 15 and 18-34 are now pending in this application.

<u>*Objection to Claim 7:*</u>

In the Office Action, claim 7 was objected to because "the" should be changed to "an" in line 10 of that claim. Based on the amendments made to claim 7 whereby the previous line 10 features are now deleted from that claim, this objection is now moot.

<u>*Claim Rejections – 35 U.S.C. § 112, 2nd Paragraph:*</u>

In the Office Action, claims 7, 9, 13, 15 and 18-21 were rejected under 35 U.S.C. § 112, 2nd Paragraph, as being indefinite, for the reasons set forth on pages 2 and 3 of the Office Action. Due to the amendments made to the claims such that the phrase "inherently printed" is no longer recited in the claims, this rejection is now moot.

<u>*Claim Rejections – Prior Art:*</u>

In the Office Action, claims 7, 9, 13, 15 and 18-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/013153 to Shinoda in view of U.S. Patent Publication No. 2003/0164974 to Yoda. This rejection is traversed with respect to the presently pending claims, for at least the reasons given below.

The combination of Shinoda and Yoda does not teach or suggest features in which a user is allowed to select an object to be printed on a surface of an image forming medium

from one of an image on a surface of a recording medium which is read by an image scanner, and image data which is read from an IC chip of the recording medium.

In the system of Shinoda, in order to achieve the desired object, i.e., insuring the reliability of the document issued by the issuer, image data registered in a database (or image data stored in an IC chip) is output to a printer or the like only when it has been confirmed that the document is a recording medium (original).

In contrast, in the invention according to independent claims 7 and 13, an image to be printed on the surface of the image forming medium (or data to be written on the IC chip which is embedded in the image forming medium) can be selected from: a) an image read by a scanner from the surface of a recording medium, and b) image data stored in an IC chip which is embedded in the recording medium, in accordance with the user's instruction.

Furthermore, Shinoda does not teach or suggest a <u>control panel</u> that allows a user to select an image to be printed on a surface of an image forming medium from one of an image that is printed on the surface of a recording medium and image data that is stored in an IC chip embedded in this recording medium. Yoda also does not teach or suggest this feature.

Still further, Shinoda and Yoda fail to teach or suggest an operation mode setting unit which sets, in accordance with the user's request input to the control panel, an image to be printed on a surface of the image forming medium as one of the image that is printed on a surface of the recording medium and the image data that is stored in the IC chip embedded in this recording medium.

Accordingly, the presently pending claims under rejection are patentable over the combined teachings of Shinoda and Yoda.

Also, with respect to claims 9 and 15, Yoda does not teach or suggest features in which the image data of the recording medium itself is written in the IC chip of the image forming medium. Rather, according to the descriptions of paragraphs [0005] to [0009] of Yoda, it seems that the invention of Yoda was conceived presupposing that the recording of image data of a recording medium in an IC chip of an image forming medium is difficult. Therefore, the feature as recited in present claims 9 and 15, i.e., to record an image that is read from the surface of the recording medium in the IC chip of the image forming medium, or to record image data that is read from the IC chip of the recording medium in the IC chip

of the image forming medium, is not derivable from the teachings of Yoda (or from the teachings of Shinoda).

Put in another way, the presently claimed invention is directed to a copying machine wherein a recording medium in which an IC chip is embedded is copied on an image forming medium in which an IC chip is embedded, or a copying method thereof. In contrast, Shinoda relates to a system for confirming whether the recorded information is original or not, and is intended for organizing the photos and additional information on photos. Thus, basically, Shinoda has a technical concept much different from that of the presently claimed invention. For example, it would not suggest itself to one skilled in the art that the system of Shinoda is based on technology which can be applied to a copying machine.

Accordingly, the presently pending claims under rejection are patentable over the combined teachings of Shinoda and Yoda.

New Claims:

New claims 22-34 have been added, whereby new claims 22-27 recite additional features of the copying machine that are not taught or suggested by the cited art of record, and whereby new claims 28-34 correspond to method claims that are counterparts to the 'copying machine' claims. Support for the new claims may be found, for example, on pages 26-41 of the specification, Figures 6-10 of the drawings, and in the originally-filed claims.

In particular, dependent claim 22 recites that the content of processing is recorded in the IC chip of the recording medium as history information. The history information is the information that shows the contents of the copying processing, which has been executed based on a processing result. The history information of the present invention is different from the additional information described in Yoda. Further, Yoda fails to teach or suggest any features for writes additional information to a <u>recording medium.</u>

Dependent claims 23 recites that the content of processing is recorded in the IC chip of the image forming medium as history information. The history information is the information that shows the contents of the copying processing, which has been executed based on a processing result. The history information of the present invention is different from the additional information described in Yoda.

Dependent claim 25 recites features in which the image on the surface of the recording medium is read, as well as the image data from the IC chip of the recording medium, and in which the image on the surface of the recording medium is printed onto the surface of the image forming medium, and in which the image that is read from the IC chip of the recording medium is recorded in the IC chip of the image forming medium, in accordance with the user's selection. These features recited in claim 25 are not taught or suggested by the cited art of record.

Dependent claim 26 recites features in which the image data from the IC chip of the recording medium is read, the image read from the IC chip of the recording medium is printed, and the image that is read from the IC chip of the recording medium is printed in the IC chip of the image forming medium, in accordance with the user's selection. These features recited in claim 26 are not taught or suggested by the cited art of record.

Dependent claim 27 recites that the image on the surface of the recording medium is read, that image is printed on the surface of the image forming medium, and the image that is read from the surface of the recording medium is recorded in the IC chip of the image forming medium, in accordance with the user's selection. These features recited in claim 27 are not taught or suggested by the cited art of record.

New claims 28-34 are method claims that correspond to "copying machine" claims 7, 9 and their respective dependent claims 22-27, whereby these claims also distinguish over the cited art of record.

Conclusion:

Since all of the issues raised in the Office Action have been addressed in this Amendment and Reply, Applicant believes that the present application is now in condition for allowance, and an early indication of allowance is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date _____*March 16, 2007*_____   By _____*Phillip J. Articola*_____

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